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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,773	08/28/2001	Masaaki Ohashi	1007-011	6753

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 9/23/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 8, 10-17, 19-21 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 8, 10-16, 21 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner notes that although the last Office action mailed May 23, 2003 was marked as a Final Rejection, the Examiner failed to indicate on the cover sheet that at that time newly presented claims 19 and 20 were rejected, which was in fact the Examiner's intention. Although applicant's latest response is entitled "AMENDMENT", and dependent claims 19 and 20 have been cancelled, the Examiner still believes it is proper to withdraw the finality of his prior action, which he has done.

3. Claims 10-12 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, claim 10 appears to be a duplicate of claim 8, and claim 11 refers to a fluororesin film, whereby claim 8 recites the presence of a polytetrafluoroethylene film. Claim 21 is vague and indefinite in that it is not seen how the claimed "film" differs from a "sheet shaped film".

4. Claims 8, 10-16 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admissions regarding the prior art as set forth in either JP -681 or JP -300 as set forth in the specification at pages 2, 3 and 4 taken in view of either Lin et al. or Kobori, substantially for the

Art Unit 1771

reasons set forth in paragraph No. 3 of Paper No. 9, together with the following additional observations. Applicant argues (Response, first and second pages of the Remarks) that JP -681 and JP -300 do not disclose a "film" to be adhered to a metal plate, but rather a "coating" on the base member. However, the Examiner respectfully submits that films are formed when a "coating" hardens, and it is also noted that applicant's claims are open ended in nature, thereby permitting the presence of a "coating" which may contain additional elements. Applicant also argues that by utilizing either of the primary references, the resulting process becomes particularly difficult to carry out. However, whether or not this may be true is seen to be irrelevant in that the relied upon prior art rejection clearly discloses, and applicant clearly claims, a genus of articles, not a particular process of coating or the like. Finally, it is again noted that Luc has been again relied upon as evidence of the state of the art and the Examiner again reiterates that the reference discloses a broad genus of fluoropolymers and related polymeric materials such as applicant's ~~preferred~~ *claimed* polytetrafluoroethylene can be bonded to a broad genus of metals by welding techniques. Although applicant has claimed a specific ^{product-by-process} type of laser spot welding, and has also included what essentially constitutes a declaration in his prior action which appears to have been resubmitted with the present action in which

Art Unit 1771

he compares other types of welding (electrical welding and CO₂ laser welding) it must be noted that these comparisons are not against the "closest prior art", i.e. as set forth in Luc. Also, it is further noted that "welding" constitutes a very broad genus of techniques which can be utilized to bond a broad genus of one type of substrate (e.g. fluoropolymers or other polymeric sheets) to another type of substrate (e.g. metals). Finally, it is again noted that other parameters, such as the thicknesses of the PTFE sheet are again believed to be well within the ordinary skill of the art, in the absence of unexpected results. In essence, applicant has again not rebutted the prima facie case of record.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE

Serial No. 09/940,773

-5-

Art Unit 1771

PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 15, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker